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DICKSTEIN SHAPIRO LLP 1633 Broadway NEW YORK, NY 10019			EXAMINER CROW, STEPHEN R	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KARL MANSER

Appeal 2009-005349
Application 10/772,014
Technology Center 3700

Decided: March 11, 2010

Before: WILLIAM F. PATE III, STEVEN D.A. MCCARTHY, and
KEN B. BARRETT, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 9-13. We have jurisdiction under 35 U.S.C. § 6(b).

The claims are directed to a belt kit for a treadmill. Claim 9, reproduced below, is illustrative of the claimed subject matter:

9. A belt kit for a treadmill, the belt kit comprising:

at least two separate belts dimensioned for use on the treadmill, the at least two separate belts each comprising a base having a plurality of projections extending upward from the base;

a first belt of the at least two separate belts having a first continuous, consistent surface;

a second belt of the at least two separate belts having a second continuous, consistent surface,

wherein the first and the second surfaces are different from each other in at least one of a size of the plurality of projections and a surface treatment,

the first belt and the second belt are dimensioned for direct foot contact, and

the first belt is dimensioned to impart proprioceptive demands on the foot, ankle and lower leg different from those of the second belt.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Kim	US 4,925,183	May 15, 1990
Dolan	US 5,066,000	Nov. 19, 1991
Shorten	US 6,029,962	Feb. 29, 2000
Naruse	US 6,210,349 B1	Apr. 3, 2001

REJECTIONS

Claims 9, 10 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim, Dolan, and Naruse. Ans. 3.

Claims 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim, Dolan, Naruse, and Shorten. Ans. 4.

OPINION

Appellant contends that the Examiner erred in concluding that the subject matter of claim 9 would have been obvious over the combination of Kim, Dolan and Naruse. App. Br. 5-7. Claims 10 and 12 are argued solely based upon their dependency from claim 9. Regarding the rejection of claims 11 and 13, Appellant only repeats the arguments proffered regarding claim 9 and contends that Shorten fails to remedy the alleged deficiencies. App. Br. 7.

Claim 9 involves no more than the predictable use of prior art elements according to their known functions. The Examiner did not err in concluding that the subject matter of claim 9 would have been obvious to one having ordinary skill in the art over the combination of Kim, Dolan and Naruse. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Appellant and the Examiner agree that Kim does not disclose multiple belts with different surfaces. App. Br. 5; Ans. 5. Appellant contends that Kim's surface irregularities are not designed to impart proprioceptive demands on the foot, ankle and lower leg. App. Br. 5-6. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *See e.g., In re Schreiber*, 128 F.3d at 1477-78. The Specification indicates that the plurality of projections provided on the mat or belt which force the user to balance himself or herself in space, are responsible for placing the proprioceptive demands upon the user's foot, ankle or leg. Spec. 2:7 – 4:15. The Examiner reasonably found that the uneven surface (at 250) of Kim's belt, having high-and-low zones and bumps, which cause the user to keep a bike in balance, thereby forcing the

stomach, back and rest of the body to exercise by constantly making adjustments, would perform this claimed function. Ans. 3; Kim col. 1, ll. 20-32; col. 4, ll. 53-56. While Kim does not explicitly state that the belt could be used for direct foot contact or to impart proprioceptive demands on the foot, ankle and lower leg, Appellant has not met his burden of establishing that Kim would not perform this function. *See In re Swinehart*, 439 F.2d 210, 212-213 (CCPA 1971). The mere recitation of the material or article intended to be worked upon by the apparatus being claimed does not impart patentability to the claims. *See e.g., In re Otto*, 312 F.2d 937, 940 (C.C.P.A. 1963); *In re Lampert*, 245 F.2d 253, 256 (C.C.P.A. 1957); *In re Rishoi*, 197 F.2d 342, 345 (C.C.P.A. 1952).

Appellant further contends that one of ordinary skill in the art would have no reason to combine the teachings of Kim and Dolan because doing so would render Kim inoperable for its intended purpose of riding a bicycle. App. Br. 6. Treadmills are notoriously known as devices for running or walking on. While the bicycle is an important part of Kim's invention, it would have been obvious to one of ordinary skill in the art that if a user desired to instead run or walk on a more "realistic" and less "monotonous" surface, the bicycle could be omitted or Kim's teaching of providing a bumpy surface could be applied to an ordinary treadmill. *See Kim* col. 1, ll. 16-17; col. 2, l. 5.

Appellant further contends that, in implementing the Examiner's proposed combination of Kim and Dolan, one of ordinary skill in the art would not arrive at the claimed first and second belts. Appellant contends one would instead arrive at a single belt having different consecutive surfaces. App. Br. 6. The fact that the combined teachings of the applied

references may render unclaimed subject matter obvious does not establish that the Examiner erred in concluding that those teachings render the claimed subject matter obvious. Combining the *teachings* of references does not mandate combination of their specific structures. *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973). One of ordinary skill in the art would understand that Dolan's teaching of providing multiple surfaces on a track for patients with balance problems to traverse could be implemented in a treadmill, such as Kim's, not only by providing a single belt with multiple surfaces as Appellant suggests, but also by providing multiple belts. *See* Dolan col. 1, ll. 6-9; col. 2, ll. 11-13 and 17-19.

Appellant's sole contention regarding Naruse, that it does not remedy any of the alleged deficiencies of the combination of Kim and Dolan, is moot since Kim and Dolan do not possess any of the alleged deficiencies. App. Br. 6-7.

DECISION

For the above reasons, the Examiner's rejection of claims 9-13 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

Vsh

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